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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,701	02/08/2002	David Z. Lubowski	5804.02	2673

20686 7590 07/17/2003

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INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

RAM, JOCELYN DEBRA

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,701

Applicant(s)

LUBOWSKI, DAVID Z.

Examiner

Jocelyn D Ram

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-15, 18, 19, 28, 29 and 32-40 is/are rejected.
- 7) ☒ Claim(s) 5-8, 16, 17, 20-27, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/363,773.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9-11, 15, 18, 19, 28, 29 and 32- 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Opie (4,852,551). Opie shows a sigmoidoscope comprising: at least one reusable part (control handle 16; optical system; valves 40, 42); at least one disposable speculum (sheath 18, including channels 22) having an observation end (30), an insertion end (20), and manually operable insufflation means (air channel 22b, 46b), which can be reusable or disposable as broadly as claimed, the speculum being adapted for insertion into a bowel cavity of a patient, and the insufflation means being adapted to insufflate the bowel cavity through the speculum with an insufflation medium thereby susceptible to contamination from within the bowel cavity; and contamination prevention means (valve 42) insulating the at least one reusable part (16; optics; 40; 42) from being exposed to any contaminated insufflation medium; said contamination prevention means is effective to prevent a contaminant from being carried by the insufflation medium from the patient to the insufflation means, and from the

insufflation means to the patient (col 10, lines 19-27); the contamination prevention means is a non-return valve; means for optically coupling a light source (col 6, lines 24-30) which is external of said speculum with said sigmoidoscope; insufflation means is an insufflation bulb (col 11, lines 25-29; conventional source of air); an observation window (eyepiece 30) with a light source (col 6, lines 21-24), and wherein the observation means comprises a light conducting system and a light imaging system (col 6, lines 16-30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Opie in view of Saslow et al. ((3,779,233). Opie shows all of the limitations of claims 12-14 except that the disposable window is openable and hingedly attached to the speculum. Saslow shows a similar sigmoidoscope that has a disposable window integral with the speculum and hingedly attached to the speculum (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use such a window to allow for easy introduction of instruments into the body.

*Allowable Subject Matter*

Claims 5-8, 16, 17, 20-27, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

The applicant's arguments hinge on the interpretation of "disposable". Once again the examiner asserts that anything and everything is essentially disposable, irrespective of the cost or "permanence" of the item. Yes, even a house or automobile is disposable since they are capable of being disposed of, i.e. a damaged automobile is disposed of in a junkyard or an old house may be purposefully burned down. This is not an overly broad interpretation of the term, but rather the term itself is broad and thus holds limited weight in claim language. If there are specific structural properties that make an object disposable, the applicant must claim this structure. Furthermore, a "reusable" part is reciprocally broad, in that anything can be reused, even if this is not the intended function.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fiore (3,889,661) shows a sigmoidoscope with the light means


isolated from contamination. Oneda et al. (5,518,501) shows a contamination protection system fro the channels of an endoscope. Harhen (5,692,729) shows a one-way valve for use in preventing contamination of the channels of an endoscope. Silverstein (5,931,833) shows a containment system to isolate the contaminated speculum. Saad (5,725,478) shows a sigmoidoscope.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JR  
July 10, 2003

  
ROY D. GIBSON  
PRIMARY EXAMINER